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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/031,149	06/03/2002	Stephen Douglas Barrett	A0000104-01-SMH	8665

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Suzanne M Harvey
Warner-Lambert Company
2800 Plymouth Road
Ann Arbor, MI 48105

EXAMINER	
WANG, SHENGJUN	
ART UNIT	**PAPER NUMBER**
1617	

DATE MAILED: 11/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/031,149	BARRETT ET AL.	
	Examiner	Art Unit	
	Shengjun Wang	1617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *23 August 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-33* is/are pending in the application.

4a) Of the above claim(s) *14,21,22,24 and 33* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-13,15-20,23 and 25-32* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. Claims 21, 22, and 24 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention. Claims 14 and 33 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a non-elected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on December 24, 2003.

2. Applicant's election without traverse of invention group VII (Now groups VII and VIII) and the species of 2,3-difluoro-6-[1,3,4]oxadiazol-2-yl-phenyl)-(4-iodo-2-methyl-phenyl)-amine as the species in the reply filed on December 24, 2003 is acknowledged.

3. Applicant's election with traverse of group VII, wherein W is 1, 3, 4-oxadiazol or thiodiazol, in the reply filed on August 23, 2004 is acknowledged. The traversal is on the ground(s) that group VII and VIII both related to compounds with five membered-hetero ring compounds. The distinct structural distinctiveness between the two groups is very minor. Applicants further contend that the different class, subclass may not used as the base for restrictions. This is not found persuasive because the compounds are distinct from each and other structurally as discussed in the prior office action. Further, in view of the number of compounds encompassed herein, search of all the invention encompassed herein would be an undue burden.

The requirement is still deemed proper and is therefore made FINAL.

The elected species was found allowable, search has expanded to non-elected species.

The claims have been examined insofar as they read on elected invention and searched species

Double Patenting Rejections

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1-13, 15-20, 23, 25-32 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 22-42 of U.S. Patent No. 6,545,030. Although the conflicting claims are not identical, they are not patentably distinct from each other because Claims 22-42 in '030 directed to method of using the compound herein for treating patient with stroke, cancers, osteoarthritis, arthritis, infections, Septic shock, complication of diabetes, transplant operation, etc. Note it should be well understood that many of the cancer patients, stroke patients, or patient with complication of diabetes suffer neuropathic pain. Therefore, practicing the claims in '030 would effectively practice the claimed invention herein.

Claim Rejections 35 U.S.C. 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-13, 15-20, 23, 25-32 are rejected under 35 U.S.C. 102(e) as being anticipated by Barrett et al. (US 6,545,030).

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

8. Barrett et al. teach the compounds herein and the method of using the same method of using the compound herein for treating patient with stroke, cancers, osteoarthritis, arthritis, viral infections, Septic shock, complication of diabetes, transplant operation, etc. Note it should be well understood that many of the patients, particularly the cancer patients, stroke patients, or patients with complication of diabetes, suffer pain, neuropathic pain in particular. Therefore, practicing the claims in '030 would effectively practice the claimed invention herein. See, particularly, col. 2-4, and the claims, particularly, claims 18-42.

Claim Rejections 35 U.S.C. 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

10. Claims 1-13, 15-20, 23, 25-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boschelli et al.

11. Boschelli et al. teach 1,3,4-thiadiazoles and 1, 3, 4-oxadiazole compounds shown as formula (I) in column 1, encompassing the compounds herein. Specifically, R5, R6, R7, R8, therein are independently hydrogen, fluoro, chloro, bromo, iodo, lower alkyl, etc. and A may be a bond. Boschelli et al. further teach the method of using the same for treating a variety of disorders, including pain, arthritis, strokes, and inflammation conditions. See, particularly, col. 1-2.

12. Boschelli et al. do not teach expressly the particular compounds herein, e.g., R6 is iodo, or A is a bond.

Therefore, it would have been prima facie obvious to a person of ordinary skill in the art, at the time the claimed the invention was made, to make and use a compound according to formula (I) in Boschelli et al. wherein R6 is iodo, and A is a bond

A person of ordinary skill in the art would have been motivated to make and use a compound according to formula (I) in Boschelli et al. wherein R6 is iodo, and A is a bond because such compounds is known to have the therapeutical effects disclosed therein. The selection of the particular compounds herein is seen to be a selection from amongst equally suitable material and as such obvious. Ex parte Winters 11 USPQ 2nd 1387 (at 1388). As to the particular pain herein recited, note Boschelli et al. teaches the usefulness of the compounds in treating pain,

inflammation in general, it would have been reasonably expected that the compounds would be useful for treating neuropathic pain cause by inflammation, such as in stroke, or after operation.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shengjun Wang whose telephone number is (571) 272-0632. The examiner can normally be reached on Monday to Friday from 7:00 am to 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan, can be reached on (571) 272-0629. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SHENGJUN WANG
PRIMARY EXAMINER

Shengjun Wang
Primary Examiner
Art Unit 1617